

REMARKS

The last Office Action has been carefully considered.

Claims 1, 3, 4, 7, 8 and 11 are rejected under 35 U.S.C. 103(a) over the patent to Grahn Wo '169 in view of the European patent document '454.

Also, claim 7 is rejected under 35 U.S.C. 112.

After carefully considering the Office Action, applicant has canceled the original claims and submitted a new set of claims 12-24 to simplify the issues.

Claim 12 substantially corresponds to the allowed 10, however a repetitive language has been canceled from this claim. It is therefore believed that claim 12 should now be in allowable condition.

Claim 13 corresponds to original claim 11, and in addition defines that there is a single piezo electric element 18.

Turning now to the prior art applied by the Examiner and in particular to the patent to Grahn, it is respectfully submitted that the device disclosed in this reference only works if two piezoelectric elements are provided.

In column 2, lines 42-56 and column 3, lines 15-20 always two actuators are mentioned. One of them is used for clamping means and the other is used for a drive actuator. It is true that in column 20, lines 64 it is mentioned that a single PDA can be used. However, this part of the specification only refers to the drive assembly. The further PDA must be used for the clamping assembly. For the device disclosed in the patent to Grahn a combination of a driving assembly and clamping assembly is necessary to work. Therefore, at least two PDA's are necessary.

In contrast, in the electromechanical drive element of the present invention as defined in claim 13, only one single piezoelectric element for driving the motor is used. The electromechanical drive element works because of a combination of the single piezoelectric element and a rotor being supported in a rotor receptacle in fashion that allows it to be rotated with friction. Therefore, a clamping element is neither needed nor present. It is therefore believed that the new features of the present

invention which are defined in claim 13 are not disclosed in the references in the patent to Grahn and can not be derived from it as a matter of obviousness.

The European patent document applied by the Examiner also does not teach these new features of the present invention as defined in claim 13.

The Examiner rejected the original claims as obvious from these two references taken singly. It is respectfully submitted as explained herein above, the references do not teach the new features of the present invention as now defined in claim 13. In order to arrive at the present invention from the teachings of the references, the references have to be fundamentally modified, by significantly changing their construction and introducing into it the present invention as now defined in claim 13. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the references do not contain any hint or suggestion for such modifications.

It is therefore believed that claim 13 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on the independent claims, they share their presumably allowable features, and therefore they should be allowable as well.

In connection with the Examiner's formal rejection of claim 7, original claim 7 which is now claim 16, it is respectfully submitted that the saw-tooth generator as mentioned in the specification on page 2, line 26, and page 4, line 22. Applicants has also submitted a new figure of the drawings showing a saw-tooth generator. Another figure showing the saw-

tooth generator is submitted herewith again. Furthermore, the a saw-tooth generator is a well known device as can be confirmed by the enclosed internet search for "saw-tooth generator".

It is therefore respectfully submitted that the rejection of the original claim 7 under 35 U.S.C. 112 should be considered as no longer applicable with respect to claim 16 and should be withdrawn.

Reconsideration and allowance of the present application is most respectfully submitted.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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